

REMARKS

Claims 1-6, 18-23, 35-40, 52-57 and 70-82 are pending in the present application. Claims 83-109 have been canceled as being subject to restriction and/or election requirement. New claim 110 has been added. Applicants respectfully request reconsideration of the pending claims in light of the following remarks.

Statement of the Substance of the Interview

At the outset, Applicant's representative thanks the Examiner for the courtesies extended during the telephonic interview conducted on July 28, 2008. During the interview, the rejection of claim 18 was discussed including that the subject matter of claim 18 was presented in the original filing of the specification. Additional aspects of the discussed arguments are presented in the following arguments regarding this rejection.

Allowable Subject Matter

Applicant notes with appreciation the indication on in the Office Action that claims 1-6, 18-23, 35-40, 52-57, 70, 71 and 73-82 are allowed.

35 U.S.C. § 101 Rejections

Claims 18-23, and 72 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicants respectfully traverse this rejection. Claim 18 and the various dependent claims recite a “computer-readable medium” which is clearly statutory subject matter (e.g., a physical element (e.g., CD, computer memory, etc.)). As recited in 35 U.S.C. §

101 and clearly acknowledged by the courts any process, machine, manufacture, or composition of matter is statutory subject matter. Accordingly, Applicants respectfully submit that there is no basis for holding a computer-readable medium as being non-statutory. Should the Examiner wish to maintain this rejection, Applicants request that the Examiner specifically state why a computer-readable medium does not meet the requirements of **any** process, machine, manufacture, or composition of matter.

In addition to the foregoing rejection, the Examiner also commented the “there is no support in the specification for the computer readable medium comprising instructions to be executed by a machine.” At the outset, Applicants respectfully submit that there is no “support in the specification” requirement for a non-statutory subject matter rejection under 35 U.S.C. § 101, the subject matter of the claim is either statutory or non-statutory. Accordingly, Applicants are unsure of what the Examiner is requesting or suggesting by this comment. However, Applicants will address aspects of the “support in the specification” below.

As stated in MPEP § 2164.01, any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. Further, as stated in MPEP § 2164.01 (I), early opinions suggest the Patent and Trademark Office was unwilling to find written descriptive support when the only description was found in the claims; however, this viewpoint was rejected. See *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980) (original claims constitute their own description); accord *In re Gardner*, 475 F.2d 1389, 177 USPQ 396 (CCPA 1973); accord *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). It is now well

accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification.

Applicant respectfully submits that claim 18 was an originally filed claim and specifically recites a “computer-readable medium”, which is reproduced below as filed

18. A computer-readable medium embodying a method for avoiding simultaneous service origination and paging in a mobile operating in a group communication network, the method comprising:

receiving a floor-control request from a source communication device for initiating a group call;

initiating a service origination process for the source communication device; and

transmitting a response to the floor-control request from a controller after the service origination process is complete.

In view of the foregoing, Applicant respectfully submits that at the very least, original claim 18 itself provides adequate support for a “computer-readable medium”. As stated in MPEP § 2163.02, the original claims constitute their own description. *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980). Additionally, as noted in MPEP § 2163.06, information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter. Therefore, if the Examiner is requesting that a description of claim 18 be amended into the specification Applicants will make such amendment.

Additionally, Applicants have provided new claim 110, which has the same format “computer-readable medium embodying a method”, as original claim 18 and has included the allowed features from claim 1. Accordingly, Applicants respectfully submit that claim 110 is directed to statutory subject matter and is fully supported by the original application as filed.

Finally, should the Examiner wish to assert that the “computer-readable medium” claims are unsupported by the specification, Applicants respectfully request that the Examiner provide reasons for this position. As stated in MPEP § 2163.04, the examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. 541 F.2d at 265, 191 USPQ at 98. See also *Ex parte Soren-son*, 3 USPQ2d 1462, 1463 (Bd. Pat. App. & Inter. 1987). In the present case, Applicants respectfully submit that “persons skilled in the art” would clearly recognize a “computer-readable medium”.

CONCLUSION

In light of the amendments and remarks contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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